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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,551	08/27/2001	Hiroshi Kobayashi	011037	1605

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ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP  
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WASHINGTON, DC 20006

EXAMINER
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CADUGAN, ERICA E

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/938,551

Applicant(s)

KOBAYASHI, HIROSHI

Examiner

Erica E Cadugan

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 August 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2, 4</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Specification*

1. The abstract of the disclosure is objected to because it contains legal phrasing such as “means” or “said”. Correction is required. See MPEP § 608.01(b).

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-3 are replete with instances that do not particularly point out and distinctly claim the subject matter of applicant's invention. Examples of these instances are listed below, but these instances are not limited to the listed examples. Applicant is advised to closely review the claims for other occurrences.

There are several positively recited limitations that lack sufficient antecedent bases in the claims. Examples of this are: “the die” in claim 1, line 4; “the upper cartridge” in claim 1, line 5; “the front and back” in claim 2, lines 2-3; “the moving-in and moving out direction” in claim 2; “the front and back cartridges” in claim 2; “the cartridge” in claim 3, line 2 (plural cartridges previously set forth); “the transferring and engaging member” in claim 3, lines 2-3; “the transferring and loading path” in claim 3 (plural previously set forth); “the transferring path of the engaging and disengaging member” in claim 3; etc. This is not meant to be an all-inclusive

list of such occurrences. Applicant is required to review the claims and correct any other such occurrences of limitations lacking sufficient antecedent basis.

4. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

An example of such idiomatic terminology is “a cartridge transferring and loading means for enabling the storing and the discharging of the upper and lower cartridges independently to the inside and outside of the press”. Note that it is particularly unclear as claimed what actions are occurring “independently”, and in what way such independent action relates to the “inside and outside” of the press as claimed.

Another example of such idiomatic terminology is found in claim 3 as a whole. For example, “engaged to the cartridge freely engaging and disengaging...” is idiomatic and unclear. Additionally, it is unclear to what the limitation “and the transferring and loading path” in claim 3, line 4, relates, i.e., what about the “transferring and loading path”?

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, as best understood, are rejected under 35 U.S.C. 102(a) as being anticipated by JP-2000-351028 ('028).

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

'028 teaches a punch press having upper 7 and lower tool cartridges, and further teaches a device for exchanging the tools between an external magazine (labeled 5 in Figure 1) and the press, and also shows that tool cartridges are held at plural positions within the press (see Figures 1-3). Thus, as best understood, the exchange device enables "the storing and the discharging of the upper and lower cartridges independently to the inside and outside of the press frame" as set forth in claim 1, and also it would thus appear that the "loading path" (see Figures 1-2) "can store at least two cartridges" as claimed in claim 2.

Additionally, regarding claim 3, it appears that the transferring path wherein the cartridges are engaged by a transferring device is in the form of a "straight line" (see Figures 1-2).

7. Claims 1-3, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 5,342,276 to Fujiwara et al. ('276).

'276 teaches a punch press (see title) 1 (see Figure 1) having a frame 3, wherein a plurality of die bases or "cartridges" 91 mounting thereon punches P (to be attached to the upper portion 5 of the turret 9) or die bases or "cartridges" 227 mounting thereon dies D (to be attached to lower portion 7 of the turret 9) are exchangeably attached to the turret 9 (see Figure 1, col. 4, lines 21-37, Figure 6, and col. 9, lines 35-36, and Figure 7 and col. 6, lines for example). The press includes a striker or "ram" for driving the punches (col. 4, lines 34-37).

Note that position 35 is the tool exchanging position, wherein an automatic die exchange device 37 performs the exchange (Figure 1, col. 5, lines 2-12, for example).

Note that it appears that the exchange device enables the "storing and the discharging of the upper and lower cartridges independently to the inside and outside of the press" as claimed, i.e., the die set storage area 27 is external relative to the frame 3, and the cartridge exchanging device enables the upper and lower tools to be stored and discharged either "outside" the press frame (at 27) or "inside" the press frame (noting that the turret 9 has a "storage" or non-punching position in which tools are held, see Figure 1) independently of one another (i.e., outside or inside independently, as best understood).

Regarding claim 2, note that, as best understood, at least two cartridges are stored in the turret 9 (see Figure 1).

Regarding claim 3, note that the transfer occurs along a straight-lined path (see figure 1, for example)

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

### ***Faxing of Responses to Office Actions and Contact Information***

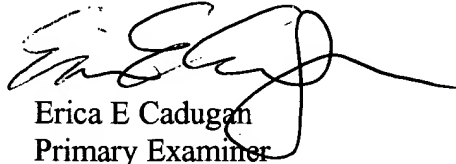
9. In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703) 872-9306. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner

Art Unit: 3722

and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erica Cadugan whose telephone number is (703) 308-6395. The examiner can normally be reached on Monday through Thursday from 7:30 a.m. to 5:00 p.m., and every other Friday from 7:30 a.m. to 4:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, A.L. Wellington can be reached at (703) 308-2159. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703) 308-1148.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Erica E Cadugan  
Primary Examiner  
Art Unit 3722

eec

June 24, 2004